# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/871,990 | 05/31/2001 | Daniel Fishman | 2378/105 | 4679 |

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| EXAMINER |
|---|
| BONSHOCK, DENNIS G |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2173 | |

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>21 June 2005</u>.

2a) ☐ This action is **FINAL**.  2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-6,8,9,11-16,23 and 33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6, 8, 9, 11-16, 23, and 33* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## Non-Final Rejection

### Response to Amendment

1.      It is hereby acknowledged that the following papers have been received and

placed on record in the file:  Amendment as received on 6-21-2005.

2.      Claims 1-33 have been examined.

Status of Claims:

3.      Claims 1-6, 8, 9, 11-16, 23, and 33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Narurkar.

4.      Claims 7, 10, 17-22, and 24-32 have been cancelled.

### Claim Rejections - 35 USC § 112

5.      The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

6.      Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement.  The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

The examiner could not find a defining of the storage location associated with the user

in the specification.

### Claim Rejections - 35 USC § 103

7.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.      Claims 1-6, 8, 9, 11-16, 23, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narurkar.

9.      With regard to claim 1, which teaches a method of transferring web-based information over a network to a personal information management system having calendar and contact data for a set of users, Narurkar teaches, in column 2, lines 10-14 and lines 22-28, a system in which data is transferred over the web to personal information management systems, where a PIM by definition contain appointment and address book information (Microsoft Computer Dictionary, 5th edition). With regard to claim 1, further teaching permitting a user to select the Web-based information on a Web page viewable in a Web browser, Narurkar teaches, in column 9, line 65 through column 10, line 5, in column 5, lines 58-67, and column 6, lines 16-28, a user selecting information for transfer via websites located on browsers. With regard to claim 1, further teaching using a toolbar associated with a web browser the tool bar having one or more selectable indicators of Web-based information type such type being selectable for a group including address and event, associated with the Web-based information so that the user can make an identification of the information type, Narurkar teaches, in column 12, lines 18-40, allowing the user to specify the type of information (specify that data is for address book) via icons on the toolbar, and further teaching in column 3, lines 15-27, providing indication of the type, by a manual mapping. Narurkar further

teaches, in column 12, line 60 through column 13, line 10, the toolbar having source

and destination icons where the destination can be an application program, executed by

a processing unit on a handheld device, and further in column 8, line 58 through column

9, line 6, the user highlighting text and data to be transferred based on selection of a

destination icon on a toolbar, where destination is and application program, where as

shown in column 9, lines 30-45 and in column 13, lines 11-25, both the source and

destination have application programs with associated data types. With regard to claim

1, further teaching creating a transfer request that includes at least the set of web-based

information and an address for a server associated with the personal information

management system and in communication with the network, Narurkar teaches, in

column 8, line 60 and in column 12, lines 50-66, a user highlighting a piece of data to be

transferred, then selecting a destination icon on the toolbar, in which to transfer it to.

With regard to claim 1, which further teaches sending the transfer request to the server,

the server having access to the calendar and contact data for the set of users, Narurkar

teaches, in column 11, lines 8-10 and lines 26-35, the request being through a server

and that the server is aware of the 'forms' of the client (sample data). With regard to

claim 1, further teaching storing the set of web-based information at the server, the set

of web-based information associated with at least one user in the set of users, in

accordance with the type identification, Narurkar teaches, in column 2, lines 10-14, the

transfer of data between disparate application programs and databases running on

disparate computer platforms including desktop computers, hand held computers, and

web servers, where the information to be transferred is selected by the user (see

column 8, lines 60-67). Though Narurkar teaches the transferring of information to a

specific application, he doesn't specifically state the "type" of application being specified

as an address or an event. It would have been obvious to one of ordinary skill in the art,

having the teachings of having the teachings of Narurkar to recognize that specifying of

the destination application provides and indication of information type. One would have

been motivated to make such a combination because Narkurkar teaches the

transferring of address based data (see column 12, line 30), and appointment data (as

is in the standard PIM), and further the providing of a toolbar for the selection of a

destination where the destination can be a specific client resident application.

10.     With regard to claim 2, which teaches the transfer request being a hypertext

transfer protocol request, Narurkar teaches, in column 3, lines 48-55, the transfer being

between computers and web servers, where it is inherently known in the art that the

standard World Wide Web protocol is http.

11.     With regard to claim 3, which teaches the Web-based information being stored in

a database in communication with the server, Narurkar teaches, in column 2, lines 10-

14, the web base information being stored in databases.

12.     With regard to claim 4, which teaches the network being the Internet, Narurkar

teaches, in column 2, lines 47-50, the transmittal of forms over the Internet.

13.     With regard to claim 5, which teaches the Web-based information being contact

information and the set of web-based information being stored with the contact data for

the at least one user, Narurkar teaches, in column 9, lines 29-35, the passed

information including first name, last name, personal title, street address, city, state

country, and zip code.

14.    With regard to claim 6, which teaches the Web-based information being and

event and the set of web-based information being stored with the contact data for the at

least one user, Narurkar teaches, in column 21, lines 55-61, the determining if the

pattern matching is using a date pattern (as would be used for a scheduled event).

15.    With regard to claim 8, which teaches sending a response from the server to the

web browser to indicate that the set of web-based information has been transferred to

the personal information management system, Narurkar teaches, in column 9, line 55,

that the system uses TCP/IP, which is known in the art to be a handshaking protocol

that sends acknowledgements (ACKS) when data has been successfully received.

16.    With regard to claim 9, which teaches web-based information being selected by a

user by highlighting information displayed by the web browser, Narurkar teaches, in

column 8, line 60-66, the user transferring data by highlighting the select text and

selecting the transfer icon.

17.    With regard to claim 11, which teaches a system for transferring web-based

information over a network to a personal information management system having

calendar and contact data for a set of users, Narurkar teaches, in column 2, lines 10-14

and lines 22-28, a system in which data is transferred over the web to personal

information management systems, which by definition contain appointment and address

book information (Microsoft Computer Dictionary, 5th edition). With regard to claim 11,

further teaching a process running on a server, in communication with a web browser,

and permitting a user to select the Web-based information on a Web page viewable in a

Web browser, Narurkar teaches, in column 9, line 65 through column 10, line 5, in

column 5, lines 58-67, and column 6, lines 16-28, a user selecting information for

transfer via websites located on browsers, where the data is provided by a server. With

regard to claim 11, further teaching using a toolbar associated with a web browser the

tool bar having one or more selectable indicators of Web-based information type such

type being selectable for a group including address and event, associated with the Web-

based information so that the user can make an identification of the information type,

Narurkar teaches, in column 12, lines 18-40, allowing the user to specify the type of

information (specify that data is for address book) via icons on the toolbar, and further

teaching in column 3, lines 15-27, providing indication of the type, by a manual

mapping. Narurkar further teaches, in column 12, line 60 through column 13, line 10,

the toolbar having source and destination icons where the destination can be an

application program, executed by a processing unit on a handheld device, and further in

column 8, line 58 through column 9, line 6, the user highlighting text and data to be

transferred based on selection of a destination icon on a toolbar, where destination is

and application program, where as shown in column 9, lines 30-45 and in column 13,

liens 11-25, both the source and destination have application programs with associated

data types.With regard to claim 11, further teaching creating a transfer request including

at least the set of web-based information selected by the user, the transfer request

directing the set of web-based information to the PIM system based on the information

type selected by the user, Narurkar teaches, in column 12, lines 60-66, the toolbar

containing transfer destination icons, for selecting a transfer to a particular destination.

With regard to claim 11, further teaching a process for sending the transfer request to

the server, at least one server, coupled to the network, to receive the transfer request

and store the set of web-based information, in a storage location associated with the

user, Narurkar teaches, in column 2, lines 10-14, the transfer of data between disparate

application programs and databases running on disparate computer platforms including

desktop computers, hand held computers, and web servers, where the information to be

transferred is selected by the user (see column 8, lines 60-67). Though Narurkar

teaches the transferring of information to a specific application, he doesn't specifically

state the "type" of application being specified as an address or an event. It would have

been obvious to one of ordinary skill in the art, having the teachings of having the

teachings of Narurkar to recognize that specifying of the destination application provides

and indication of information type. One would have been motivated to make such a

combination because Narkurkar teaches the transferring of address based data (see

column 12, line 30), and appointment data (as is in the standard PIM), and further the

providing of a toolbar for the selection of a destination where the destination can be a

specific client resident application.

18.     With regard to claim 12, which teaches the transfer request being a hypertext

transfer protocol request, Narurkar teaches, in column 3, lines 48-55, the transfer being

between computers and web servers, where it is inherently known in the art that the

standard World Wide Web protocol is http.

19.    With regard to claim 13, which teaches the Web-based information being stored

in a database in communication with the server, Narurkar teaches, in column 2, lines

10-14, the web base information is stored in databases.

20.    With regard to claim 14, which teaches the Web-based information being contact

information and the set of web-based information being stored with the contact data for

the at least one user, Narurkar teaches, in column 9, lines 29-35, the passed

information including first name, last name, personal title, street address, city, state

country, and zip code.

21.    With regard to claim 15, which teaches the Web-based information being and

event and the set of web-based information being stored with the contact data for the at

least one user, Narurkar teaches, in column 21, lines 55-61, the determining if the

pattern matching is using a date pattern (as would be used for a scheduled event).

22.    With regard to claim 16, which teaches web-based information being selected by

highlighting information displayed by the web browser, Narurkar teaches, in column 8,

line 60-66, the user transferring data by highlighting the select text and selecting the

transfer icon.

23.    With regard to claim 23, which teaches presenting a confirming indicator on the

toolbar, the confirming indicator confirming transfer of web-based information to the

PIMS, Narurkar teaches, in column 16, line 30 through column 17, line 26, a

communication between the server and the client determining the status of the transfer,

but doesn't specifically teach displaying the status in a toolbar. Narurkar does teach a

browser (see column 9, line 65 through column 10, line 13), where browsers are known

in the art to contain a status bar. It would have been obvious to one of ordinary skill in
the art, having the teachings of Narurkar before him at the time the invention was made
to modify the toolbar to contain status information. One would have been motivated to
make such a combination because the standard web browser contains a status bar.

24.     With regard to claim 33, which teaches the user-interaction with one of the
selected indicators also initiates transfer of the Web-based information, Narurkar
teaches, in column 8, lines 60-67 and column 12, line 60 through column 13, line 10,
sending the information upon user selection of a destination icon on the toolbar.

### *Response to Arguments*

25.     The arguments filed on 6-21-2005 have been fully considered but they are not
persuasive. Reasons set forth below.

26.     The applicants' argue that Narurkar doesn't teach graphically selecting text on a
webpage.

27.     In response, the examiner respectfully submits that Narurkar teaches, in column
8, lines 58-67, the users ability to highlight plain text or data fields in the source and
select a destination icon to transfer the information to.

28.     The applicants' argue that Narurkar doesn't teach selecting an information type
(calendar information, address information) for the selected text.

29.     In response, the examiner respectfully submits that Narurkar teaches, in column
12, lines 18-40, allowing the user to specify the type of information (specify that data is
for address book, or appointment data) via icons on the toolbar, and further teaching in
column 3, lines 15-27, providing indication of the type, by a manual mapping. Narurkar

further teaches, in column 12, line 60 through column 13, line 10, the toolbar having

source and destination icons where the destination can be an application program,

executed by a processing unit on a handheld device, and further in column 8, line 58

through column 9, line 6, the user highlighting text and data to be transferred based on

selection of a destination icon on a toolbar, where destination is and application

program, where as shown in column 9, lines 30-45 and in column 13, lines 11-25, both

the source and destination have application programs with associated data types.

30.     The applicants' argue that Narurkar doesn't teach creating a transmission based

on the information type that was selected.

31.     In response, the examiner respectfully submits that Narurkar teaches, in column

8, lines 60-67 and column 12, line 60 through column 13, line 10, sending the

information upon user selection of a destination icon on the toolbar. Where the

destination icon, as shown above, provides an indication of the which application (type)

the information pertains to.

32.     The applicants' argue that Narurkar doesn't teach selection of Web-based

information type.

33.     In response, the examiner respectfully submits that Narurkar teaches, in column

9, line 65 through column 10, line 5, in column 5, lines 58-67, and column 6, lines 16-28,

a user selecting information for transfer via websites located on browsers.

### Conclusion

34.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dennis G. Bonshock whose telephone number is (571)
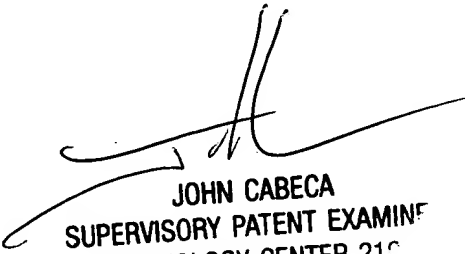
272-4047. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 4:00

p.m.

35.    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

36.    Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


6-30-05
dgb

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